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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

TAYLOR, JANELLE

ART UNIT PAPER NUMBER

1634

DATE MAILED: 09/16/2002 20

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/608,066

Applicant(s)

ASTATKE ET AL.

Examiner

Janell Cleveland Taylor

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 28 June 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 81 and 82 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 81 and 82 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☒ Other: *Detailed Action*.

### DETAILED ACTION

The following is a FINAL REJECTION. Any rejection not reiterated is withdrawn. A "Response to Arguments" follows.

#### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 81-82 are rejected under 35 U.S.C. 102(b) as being anticipated by Goff et al.

3. Claim 81 is drawn to a method for preparing cDNA from mRNA, comprising: mixing one or more mRNA templates with one or more reverse transcriptases, and with one or more double stranded nucleic acid inhibitors; and incubating said mixture under conditions sufficient to synthesize one or more cDNA molecules complementary to all or a portion of said templates. Claim 82 is drawn to the method of claim 81, wherein said mixing is accomplished under conditions sufficient to prevent nucleic acid synthesis and/or allow binding of said one or more double stranded nucleic acid inhibitors to said reverse transcriptase.

4. Goff et al teaches expression of enzymatically active reverse transcriptase. Goff teaches product analysis using human reticulocyte polyA(+) RNA as template.

Specifically, Goff teaches reaction mixtures containing RNA and Actinomycin D (which binds preferentially to double stranded nucleic acids and inhibits the second strand

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synthesis), and synthesis with AMV reverse transcriptase. Specifically, Goff teaches "DNA synthesis was performed in the presence of actinomycin D. Actinomycin D binds preferentially to double-stranded nucleic acids and therefore inhibits the second strand synthesis." Also, Goff teaches the use of the reverse transcriptase pB6B15.23. "The major products of cDNA synthesis of reticulocyte polyA + RNA with pB6B15.23 reverse transcriptase in the presence of actinomycin D were the 600 base species." (Col. 26). Therefore, Goff anticipates the claims by teaching cDNA synthesis from mRNA templates in the presence of both a reverse transcriptase and a double stranded nucleic acid inhibitor. Furthermore, Goff teaches that nucleic acid synthesis of the second strand is inhibited (as taught in claim 82) by the use of actinomycin D.

### ***Summary***

Claims 81-82 are pending. Both claims are rejected under 35 U.S.C. 102(b). No claims are free of the prior art and no claims are allowable.

### ***Response to Arguments***

1. Applicant's arguments filed July 8, 2002 have been fully considered but they are not persuasive. Applicant has argued that Goff does not disclose the use of inhibitors or reverse transcriptase activity, but rather of double stranded nucleic acids. While this is true, the rejection is consistent with the claim language found in the claims. If Applicant meant "inhibitory nucleic acids", as they claim, which are themselves inhibitory, then the claims should be amended to clearly recite their purpose. Otherwise, one of reasonable skill in the art would interpret "double stranded nucleic acid inhibitors" as inhibitors of double stranded nucleic acids, not reverse transcriptase. MPEP 2173.05(a) states that

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"A TERM MUST NOT BE GIVEN A MEANING REPUGNANT TO ITS USUAL MEANING." While a term used in the claims may be given a special meaning in the description of the invention, generally no term may be given a meaning repugnant to the usual meaning of the term. In re Hill, 161 F.2d 367, 73 USPQ 482 (CCPA 1947).

***Conclusion***

1. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiries of a general nature relating to this application, including information on IDS forms, status requests, sequence listings, etc. should be directed to the Patent Analyst, Chantae Dessau, whose telephone number is (703) 605-1237.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janell Taylor Cleveland, whose telephone number is (703) 305-0273.


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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Jones, can be reached at (703) 308-1152.

Papers related to this application may be submitted by facsimile transmission. Papers should be faxed to Group 1634 via the PTO Fax Center using (703) 872-9306 or 872-9307 (after final). The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG (November 15, 1989.)

Janell Taylor Cleveland

September 6, 2002

  
W. Gary Jones  
Supervisory Patent Examiner  
Technology Center 1600